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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,673	10/31/2001	Sang-Hoon Kim	P/4006-3	3185

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OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

C.S.

Office Action Summary

Application No. 10,001,673	Applicant(s) Kun Et. Al
Examiner Daniel Zirker	Group Art Unit 1771

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4/26/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-5, 7-29 is/are pending in the application.
- Of the above claim(s) 24-29 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5, 7-23 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☒ The proposed drawing correction, filed on 4/26/04 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))
- *Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Newly submitted claims 24-29 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: More particularly, as applicants admit in their latest response at page 10, second paragraph, there is a significant difference between "substrate" with which they have amended their previously pending claims throughout and the term "film" which is found in all of the newly presented claims, which they state, "might tend to suggest a particular composition or group of compositions and thus might be considered both narrower than "substrate" as well as potentially inconsistent from embodiment to embodiment". Accordingly, it is clear that independent claim 24, as well as the accompanying dependent claims 25-29 are of significant differing scope than those presently pending claims which would otherwise closely mirror the newly submitted claims. Additionally, it is further noted that independent claims 1, 2, 10 and 20 all set forth the limitation that an adhesive section on the first side of the "substrate" is in contact with said second side" which limitation is not found in newly presented claim 24.

Since applicants have received an action on the merits for the originally presented invention, this invention has been

constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-29 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03.

3. Claims 1-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicants' admissions in the specification on pages 1 and 2, particularly page 1 lines 10-20 and page 2 lines 10-22 taken in view of Leander, substantially for the reasons set forth initially in paragraph No. 5 of Paper No. 6, together with the following additional observations. To somewhat reiterate, the Examiner notes that applicants appear to admit that essentially their entire invention in all of its various embodiments as a single sided adhesive tape, double sided adhesive tape, and notepads are known to one of ordinary skill in the art, except for the absence of the presence of rows and other forms such as various geometric stripes of adhesive which are coated on either one or both sides of the tape substrate in various geometries, with the adhesive rows or stripes being separated by adjacent rows or stripes of an adhesive free section. However the secondary reference Leander clearly discloses the presence of an adhesive layer applied in patterns or narrow rows and various other geometries that are alternated with or separated by spaces or rows free from adhesive (column 1

lines 15-19) and the accompanying advantages accruing therefrom.

Accordingly, one of ordinary skill, motivated by an expectation of improved adhesive tape performance (note, e.g. tapes are expressly taught at column 2 line 12 of Leander) would incorporate the parallel rows of adhesive 12 which are separated by alternative rows 13 free of adhesive into the admitted prior art embodiments set forth on pages 1 and 2 of the specification and thereby either form or clearly put in the possession of the skilled artisan, the claimed genus of articles. Note additionally that in applicants' independent claims, particularly claims 1 and 2 which require "an adhesive section on said first side is in contact with said second side" (claim 1) and similarly elsewhere require the adhesive tapes to simply be present on a roll, which is specifically set forth in applicants' specification at page 2 line 19, as well as its additional earlier recitation of Scotch brand tapes, these sections being among those which have been relied upon by the Examiner for the admissions. Note also that such embodiments as the presence of adhesive notepads and dispensers containing the tape are admitted as well known to one of ordinary skill in the art. With respect to the embodiments that are coated on both sides with an adhesive, the Examiner believes that the rationale for applying such rows of adhesive which are separated by alternate rows that

are free of adhesive applies equally well to these embodiments as it does to just single sided coated tape surfaces. Although Leander teaches only one of the surfaces as being coated with adhesive patterns, the Examiner further believes that it is well within the ordinary skill of the art to coat both surfaces with adhesive if such is so desired, as is set forth above. Other parameters that are not either expressly or inherently disclosed are again believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through

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private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

June 17, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zirker